

REMARKS

I. Introduction

Claims 1-25 are currently pending in the present application. Claims 1, 18, and 22 are independent. All pending claims stand rejected. In particular:

(A) all pending claims (claims 1-25) stand rejected under 35 U.S.C. §101 as being allegedly drawn to non-statutory subject matter; and

(B) all pending claims (claims 1-25) stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 4,654,800 (hereinafter "Hayashi") in view of U.S. Patent No. 5,780,133 (hereinafter "Engstrom").

Upon entry of this amendment, which is respectfully requested, claims 1, 8-9, 13, 18, and 22 will be amended to correct minor informalities as well as to update the pending claims with respect to recent developments in §101 case law (*e.g.*, not for reasons related to overcoming any cited reference). No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. Incomplete Office Action

Applicants respectfully note that the Examiner has purposefully only examined (or at least purposefully only provided reasons for rejecting) the first ten (10) claims of the pending twenty-five (25) claims. Office Action, pg. 6, lines 15-16. Applicants respectfully point out that not only is it required that every claim and every claim limitation be examined (or at least reasons for rejection thereof be provided), but "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) MPEP §2143.03. The Examiner has failed to do so for this application.

Applicants also respectfully note that "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." MPEP §706.02(j). Indeed, it is required that "[t]he

examiner's action will be complete as to all matters" (37 C.F.R. §1.104(b); MPEP §707.07), for "[p]iecemeal examination should be avoided as much as possible". MPEP §707.07(g).

Further, failure to properly address claims and/or claim limitations constitutes improper "Notice of Rejection" pursuant to 35 U.S.C. §132. Specifically, Applicants respectfully note that 35 U.S.C. §132 "is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection. See, e.g., *In re Wilke*, 50 C.C.P.A. 964, 314 F.2d 558, 562, 136 USPQ 435, 439 (1963)." *Chester v. Miller*, 906 F.2d 1574 (Fed. Cir. 1990).

In this case, with respect to each of claims **11-25** that the Examiner has failed to properly address, as the Office Action fails to allow Applicants to effectively counter the outstanding rejections as set forth, in contravention of 35 U.S.C. §132, Applicants respectfully request that a **new Non-final Office Action** clarifying the current rejections, properly reflecting the status of all claims, and properly addressing all claim limitations, **be provided**.

III. The Examiner's Rejections

A. 35 U.S.C. §101 Rejections

All pending claims (claims **1-25**) stand rejected under 35 U.S.C. §101 as being allegedly drawn to non-statutory subject matter. While Applicants do not necessarily agree with this ground for rejection, as independent claims **1**, **18**, and **22** are amended herein to more explicitly recite a particular machine (in accordance with recent developments in case law), this ground for rejection is rendered *moot*.

At least for this reason, Applicants respectfully request that this §101 ground for rejection of all pending claims (claims **1-25**) be **withdrawn**.

B. 35 U.S.C. §103(a) Rejections – Havashi, Engstrom

All pending claims (claims **1-25**) stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Havashi in view of Engstrom. Applicants traverse this ground for rejection as follows.

Applicants respectfully note the Examiner's §103(a) ground for rejection of the pending claims fails on many grounds.

First, Applicants have reviewed the portions of Hayashi cited by the Examiner (as well as the remainder of Hayashi) and must respectfully submit that **not a single limitation** of the pending claims **is taught or suggested** (in some cases even remotely or arguably) by Hayashi.

Second, Engstrom simply and entirely fails to make up for any of the many deficiencies of Hayashi. The Examiner, for example, relies upon Engstrom for allegedly teaching "a subscription" (Office Action, pg. 5, lines 3-9; which the Examiner admits Hayashi fails to contemplate – Office Action, pg. 5, line 3). Applicants have reviewed the cited portions of Engstrom (as well as the remainder of Engstrom) and are entirely at a loss as to how the Examiner can equate the dual-value coupon of Engstrom with any sort, type, or configuration of "a subscription". **Coupons are simply not equivalent to "subscriptions"**.

Third, even if Engstrom made up for some or all of the deficiencies of Hayashi, **Engstrom is non-analogous art**. Engstrom, for example, is not in the vending machine arts, nor does Engstrom appear in any way directed to solving any problem related to the pending claims.

Fourth, even if Engstrom was analogous art and even if the combination of Hayashi and Engstrom taught or suggested every limitation of the pending claims (none of which, Applicants maintain, has occurred in this case), the Examiner has failed to provide any reason (much less evidence) that one of ordinary skill would have had to combine Hayashi and Engstrom.

Accordingly, the Examiner has entirely failed to set forth a *prima facie* case of obviousness for any pending claim.

At least for these reasons, Applicants respectfully request that this §103(a) ground for rejection of all pending claims (claims **1-25**) be **withdrawn**.

IV. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested. Applicants' silence with respect to any comments made in the Office Action does not imply agreement with those comments.

Alternatively, if there remain any questions regarding the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number (203) 438-6867 or via e-mail at cfincham@finchamdowns.com, upon the Examiner's convenience.

V. Fees and Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Applicants' Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Applicants' Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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